IN THE DRAWINGS

The attached sheet of drawings includes changes to Fig. 1. This sheet, which includes Fig. 1, replaces the original sheet including Figs. 1-4.

Attachment: Replacement Sheet

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the present amendments and following discussion, is respectfully requested.

Claims 20-47 are pending. By this Amendment the specification, Fig. 1 and Claims 20 and 24 are amended and new Claims 38-47 are added. Support for the amendments is self-evident from the specification. No new matter has been added.

Applicants appreciate the Office Action's indication that Claims 22, 27-33 and 38 contain allowable subject matter.

The Office Action objects to the specification. The specification is amended to obviate this objection, by removing references to the claims.

The Office Action objects to the drawings. Fig. 1 and the specification are amended to obviate this objection. The fastening support pipe is shown in Fig. 1.

The Office Action rejects Claims 20 and 24 under 35 U.S.C. § 112, second paragraph. Claims 20 and 24 are amended to obviate this rejection by correcting informalities.

The Office Action rejects Claims 20, 21, 23, 26 and 34-37 under 35 U.S.C. § 102(b) over USP 5,306,238 to Fleenor, Claim 20 under 35 U.S.C. § 102(e) over USP 6,558,383 to Cunningham et al., Claims 20 and 35 under 35 U.S.C. § 102(e) over USP 7,004,939 to Mackay and Claims 24, 25 and 26 under 35 U.S.C. § 103(a) over Fleenor in view of USP 5,836,909 to Cosmescu. These rejections are respectfully traversed.

Before considering the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103, it is believed that a brief review of the subject matter of independent Claim 20 would be helpful. Independent Claim 20 is directed to an applicator for an electrosurgical instrument. A gas and high frequency current terminal is included. A cutting electrode is attached to a gas and high frequency current supply pipe. An insulating cap is configured to detachably fasten the applicator on a handle of the instrument. An insulating casing tube is displaceable relative to

a common longitudinal axis of the applicator for exposing or covering the cutting electrode. The casing tube surrounds the gas and high frequency current supply pipe along a longitudinal section. A collar or an external right-angle bend is provided at a distal end of the casing tube. At least one radially surrounding gas-sealing inhibiting device is arranged between an inside of the casing tube and an outside of the gas and high frequency current supply pipe. The inhibiting device allows a respective position to be frictionally fixed at any location of a path of displacement of the casing tube.

With respect to the rejection of Claim 20 under 35 U.S.C. § 102(b) over Fleenor, Fleenor does not disclose a cutting electrode attached to a gas and high frequency current supply as in Claim 20. See element 3 in Figure 1. The Office Action equates electrode 12 and passageway 82 of Fleenor with the cutting electrode and the gas and current supply pipe, respectively. However, the passageway 82 does not serve to supply both a gas and a high frequency current and is thus not equatable with the gas and high frequency current supply pipe of Claim 20. The gas and high frequency current supply pipe serves to supply both a gas and a high frequency current.

As recited at column 6, lines 21-25 of Fleenor, "[T]he tail portion 20, nose portion 18 and boot assembly (i.e., 28 and 30) are constructed and interconnected to define inner passageway(s) 82 for the delivery of inert gas from gas supply host 56 to the nozzle 14 during gas-enhanced second mode operations." Thus, if Fleenor discloses that tail portion 20, nose portion 18 and the boot assembly together constitute a supply pipe, then inner boot 28 and intermediate boot 30 constituting the boot assembly are taught at column 4, lines 48-50 as being fabricated from a nonconductive material, specifically elastomer or polyurethane. It is apparent from Fig. 1 and Fig. 2 of Fleenor that tail portion 20 and nose portion 18 will be likewise nonconductive for the sake of preventing inadvertent electrical contact with the patient. Thus, Fleenor does not disclose that these portions can supply a current.

Furthermore, Fleenor does not disclose an insulating cap configured to detachably fasten the applicator on a handle of the electrosurgical instrument as in Claim 20. The Office Action equates tail portion 20 of Fleenor with an insulating cap. However, Fleenor does not disclose any teaching that tail portion 20 is configured to detachably fasten the applicator on a handle of an electrosurgical instrument. Accordingly, Fleenor does not disclose this feature.

Fleenor does not disclose insulating a casing tube surrounding the gas and high frequency current supply pipe over a longitudinal section as in Claim 20. The Office Action equates nozzle 14 and nose portion 18 of Fleenor with the insulating tube and passageway 82 of Fleenor with the gas and current supply pipe. However, the passageway 82 is not equatable with the gas and high frequency current supply pipe as discussed above. Moreover, as shown at e.g. Figs. 1 and 2 of Fleenor, neither nozzle 14 nor nose portion 18 surrounds passageway 82 over a longitudinal section.

With respect to the rejection of Claim 20 under 35 U.S.C. § 102(e) over Cunningham, Cunningham does not disclose a cutting electrode attached to a gas and high frequency current supply pipe. The Office Action equates electrode 68 and gas tube assembly 64 of Cunningham with the cutting electrode and the gas and current supply pipe respectively. However, the gas tube assembly 64 does not serve to supply both a gas and a high frequency current and thus is not equatable with the claimed gas and high frequency current supply pipe, that serves to supply both a gas and a high frequency current. See element 3, in Fig. 1 of the specification. Instead, as disclosed e.g. at col. 8, lines 36-40, 50-58 and 59-61, electrode 68 of Cunningham is connected to an RF energy source via contact portion 94c, power source activator 96, switch assembly 98 and circuitry assembly 100.

Cunningham does not disclose an insulating casing tube displaceable relative to a common longitudinal axis of the applicator as in independent Claim 20. The Office Action

equates support member 18 of Cunningham with the insulating casing tube. However, Cunningham at col. 5, lines 58-59 does not disclose that the support member 18 is in any way displaceable relative to a common longitudinal axis of an element of Cunningham equatable to the applicator. Instead, as disclosed at column 4, lines 9-11, Cunningham proposes adjustment of electrode assembly 16 within support member 18.

With respect to the rejection of Claim 20 under 35 U.S.C. § 102(e) to Mackay, Mackay does not disclose an insulating casing tube displaceable relative to a common longitudinal axis of the applicator for exposing or covering the cutting electrode as in independent Claim 20. The Office Action equates nozzle 401 of Mackay with an insulating casing tube. However, Mackay does not disclose that nozzle 401, for exposing/covering a cutting electrode is in any way displaceable relative to a common longitudinal axis of an element of Mackay equatable to the applicator. Instead, as disclosed at column 7, lines 46-62, Mackay discloses electrode 212 is adhesively fastened, welded or brazed to electrode holder 403 such that electrode 212 is firmly retained in nozzle 401.

Furthermore, Mackay does not disclose a gas sealing inhibiting device arranged between an inside of the casing tube and an outside of the gas and high frequency current supply pipe wherein the inhibiting device allows that a respective position be frictionally fixed at any location of a path of displacement of the casing tube as in Claim 20. The Office Action equates plenum 213, nozzle 401 and channel 408 of Mackay with the gas sealing device, the casing tube and the gas and high frequency current supply pipe, respectively. However, the plenum 213 of Mackay is not equatable with the gas sealing inhibiting device. Specifically, the plenum 213 of Mackay is not arranged between an inside of nozzle 401 and an outside of channel 408. As disclosed at column 7, lines 20-25, Mackay discloses that channel 408 constitutes an inside of nozzle 401.

Fleenor and Cunningham do not disclose a supply pipe configured to communicate a gas flow and high frequency current as in new Claim 39. Mackay does not disclose an insulating member configured for displacement relative to the supply pipe in the direction of a longitudinal axis of the supply pipe as in new Claim 39.

Cosmescu does not cure the deficiencies of Fleenor, Cunningham and Mackay described above.

The dependent claims are allowable for at least the reasons discussed above as well as for the individual features they recite. Withdrawal of the rejection of the dependent claims is respectfully requested.

For the foregoing reasons, it is respectfully submitted that this application is now in condition for allowance. A Notice of Allowance is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even between form for allowance, the Examiner is encouraged to contact the Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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